

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28  
29  
30  
31  
32  
33  
34

RECORD OF ORAL HEARING  
UNITED STATES PATENT AND TRADEMARK OFFICE  

---

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

---

Ex parte TOMOYUKI ASANO

---

Appeal 2006-3185  
Application 08/865,403  
Technology Center 3600

---

Oral Hearing Held: October 25, 2007

Before MURRIEL CRAWFORD, LINDA E. HORNER (telephonically),  
and JOSEPH A. FISCHETTI, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

JOEL R. MERKIN, ESQUIRE  
Sonnenschein Nath & Rosenthal LLP  
7800 Sears Tower  
233 South Wacker Drive  
Chicago, IL 60606-6404

The above-entitled matter came to be heard on October 25, 2007,  
commencing at 9:00 a.m., at the United States Patent and Trademark Office,

1600 Dulany Street, 9<sup>th</sup> Floor, Hearing Room A, Alexandria, Virginia, before  
2Lori B. Allen, Notary Public.

3 PROCEEDINGS  
4

5 JUDGE CRAWFORD: Good morning, Mr. Merkin.

6 MR. MERKIN: Good morning.

7 JUDGE CRAWFORD: These are two of our newer administrative  
8patent judges back here, not members of the public.

9 We have another Judge here on the phone, Judge Horner.

10 JUDGE HORNER: Good morning.

11 JUDGE CRAWFORD: So you can begin whenever you're ready.

12 MR. MERKIN: Thank you.

13 Good morning, Your Honors. May it please the Board, my name is  
14Joel Merkin, Registration Number 58600, appearing on behalf of the  
15appellant Sony Corporation.

16 The application at issue is a relatively straightforward invention; and I  
17am here today to explain to the Board why the rejection by the examiner  
18should be reversed. The appellant respectfully submits that the examiner is  
19in error by giving a single claim term, the term service request, two different  
20meanings within representative claim 9 in order to allow the claim to read in  
21the prior art.

22 As I will explain, the examiner defined the term, "service request," in  
23the final office action of June 6, 2001, to be a request for information or a  
24service of interest. The examiner defined the term "service request," in his  
25examiner's answer to be the countersigned EPO, or electronic purchase  
26order. Using either of these definitions, claim 9 is not anticipated by the

1cited art, Sirbu, because there are limitations in the claim that are simply not  
2alone and present in Sirbu.

3 JUDGE HORNER: Can I interrupt you for one moment and ask you  
4to explain for us in terms of your own specification how you would define  
5service request. What would be included within a service request?

6 MR. MERKIN: Your Honor, I would define service request, I guess,  
7roughly as a request from the user terminal to the service provider to provide  
8a service. I know that is a rather circular definition, but an example would  
9be a request to connect to the Internet, or a request to provide a specific  
10service from the service provider to the user terminal.

11 JUDGE HORNER: Would it include, for example, a request to  
12provide an encryption key?

13 MR. MERKIN: Your Honor, I believe it would request to provide an  
14encryption key, if the service would be defined as receiving the encryption  
15key, which I think could be a valuable service than it would appear to be that  
16the request for that service would fall within the scope of the term, "service  
17request."

18 JUDGE HORNER: Okay, so the examiner as you pointed out, I  
19think, correctly, had two different ways to interpret service requests in terms  
20of the prior art. But I want to propose a third definition or equivalent to  
21service request in the Sirbu reference, and that is to consider whether the  
22electronic payment order sent by the user to the service provider, not the  
23countersigned EPO, but the actual original EPO. Why would that not be a  
24service request? It's requesting that the service provider go ahead and take  
25payment out of the user's account and also provide the user with an  
26encryption key.

11

1 MR. MERKIN: Yes, Your Honor. It is my understanding that that  
2 original, electronic purchase order from the customer to the merchant, which  
3 I believe is what you're referring to?

4 JUDGE HORNER: Yes.

5 MR. MERKIN: Could be considered a service request; but then if  
6 you were to define the service request as that EPO, other steps within the  
7 claim require that the service request is then transmitted from the merchant  
8 or the service provider to the accounting service. And it's the countersigned  
9 EPO that is provided to the accounting server from the service provider.

10 JUDGE HORNER: But this is the countersigned EPO. Doesn't that  
11 have subsumed within it, the original EPO? So by virtue of the service  
12 provider sending the countersigned EPO to the accounting server, the service  
13 provider is also sending the original EPO that's subsumed within the  
14 countersigned EPO?

15 MR. MERKIN: Yes, Your Honor, I believe you are correct. And the  
16 countersigned EPO, I believe, is a modified original EPO sent from the user  
17 to the merchant, but I would say that that interpretation fails for a couple  
18 reasons. One is that the claim language is defining a single service request  
19 from the first step. I guess we're receiving a service request to the last step  
20 which is providing said service request. So it's referring to the same service  
21 request, not a larger service request that has some of the same components  
22 within it.

23 So that's one reason why that interpretation, even if you were to  
24 interpret the original service request to be a service provider, then you still  
25 ran into problems where the service request in the fourth step of the claim is  
26 not that same service request. And also, the examiner very clearly in the

1examiner's answer defined that original service request as the disclosure  
2request. So again, you're going to run into a similar situation where what  
3was previously defined as the disclosure request, and this is in the  
4examiner's answer underlined as -- it's not a page number, but it's under  
5heading 13 where it's underlined -- "the electronic payment order already  
6received from the customer" -- and then in parentheses, a disclosure request.

7 JUDGE HORNER: So your argument is that if we rely on the  
8original EPO from the user or a customer as being the service request, we  
9can't also say that that would constitute a disclosure request.

10 MR. MERKIN: Yes, that is what I'm saying.

11 JUDGE HORNER: It couldn't satisfy both limitations.

12 MR. MERKIN: Right, and the examiner frankly has defined that  
13original EPO as a disclosure request and hasn't provided any other element  
14that correlates the disclosure request if you were to define the original EPO  
15as the service request.

16 JUDGE HORNER: Okay. I think I understand your arguments. I  
17didn't mean to sidetrack you if you want to go ahead with the rest of your  
18argument.

19 MR. MERKIN: Well, thank you. And you covered much of my  
20argument.

21 JUDGE HORNER: Okay.

22 MR. MERKIN: Only when the term "service request" is defined one  
23way in one step, and another way in another step, can Sirbu anticipate claim  
249. In the final office action of June 6, 2001, the examiner read the term,  
25"service request," in Sirbu, by citing the column 4, lines 35 to 50 of Sirbu,  
26which makes clear that the service request for information or of a service of

1interest. Using this definition of service request, Sirbu does not disclose the  
2fourth step of claim 9, which recites "providing said service request and said  
3digital signature to said accounting terminal when a disclosure request or the  
4service request and digital signatures is received." This is because a request  
5for information or a service of interest as the examiner has defined 'service  
6request' is never provided to the accounting terminal.

7        Rather, a countersigned EPO is sent to the account server. Sirbu  
8states that the countersigned EPO may include customer identity, product  
9identifier, negotiated price, merchant identifier, a cryptographic check sum  
10and digital signature. But Sirbu does not include a service request within the  
11countersigned EPO. Further, Sirbu neither discloses nor suggests that the  
12service provider receives a disclosure request for the service request and  
13digital signature. In the examiner's answer to appellant's appeal brief, the  
14examiner changed course and defined very clearly that the service request is  
15the countersigned EPO.

16        However, if this is the case, since the first step of claim 9 recites  
17receiving a service request that comes from the user terminal, the user  
18terminal in claim 9 must then correlate to the merchant in Sirbu since the  
19merchants transmit the countersigned EPO. And the service provider in  
20claim 9 must then correlate to the account server in Sirbu, since the account  
21server provides the service request, according to the examiner's definition.  
22And if this is the case, then Sirbu does not disclose at least the third step of  
23claim 9, which recites requesting a charge collection from an accounting  
24terminal, since there is no corresponding element remaining to be the  
25accounting terminal in Sirbu.

1 In some, the examiner defines a service request as a request for  
2information or a service of interest as it did in the final office action, then  
3Sirbu does not disclose all of the limitations present in claim 9. Yet, if the  
4examiner insists on defining the service request as a countersigned EPO as it  
5did in the examiner's answer, then Sirbu also does not disclose all the  
6limitations present in claim 9. Only when the term service request is defined  
7one way in one step and another way in another step can Sirbu anticipate  
8claim 9.

9 JUDGE HORNER: Could we go back just a minute to the issue of the  
10original EPO being the service request?

11 MR. MERKIN: Yes, Your Honor.

12 JUDGE HORNER: And the way I see that, the sending by the  
13customer of that original EPO to the merchant serves two purposes. First,  
14it's requesting a decryption key saying I received the goods, but now I need  
15the decryption key. And it also could be considered to be a disclosure  
16request, because the customer is saying I received the goods. So you can go  
17ahead and disclose to the account server what you sent me so that you can  
18get paid.

19 So is there anything in the claim that would require the service request  
20and the disclosure request to be different things sent or requests that were  
21sent separately?

22 MR. MERKIN: There's nothing in the claims that expressly requires  
23the service request and the disclosure request to be two separate elements.  
24But I believe that is a broad interpretation of what the disclosure request is to  
25read the same element from Sirbu on both the disclosure request and the  
26service request. As an initial matter, I think it's a stretch to consider the

1original EPO as a service request, because as I mentioned, the disclosure of  
2Sirbu lists what is contained within the original EPO, and one thing that's not  
3contained within the original EPO is a service request. But I understand  
4your point that it can be used to request an encryption that just doesn't seem  
5to be specifically recited.

6 JUDGE HORNER: Right. So that would be almost an inherent  
7feature of the EPO itself that what results is that they eventually get the  
8decryption key back, but there's no explicit request within the EPO itself  
9saying please send me the key.

10 MR. MERKIN: Right, and if you do consider that EPO that original  
11EPO to also be a disclosure request, it seems to me that it's being defined as  
12a disclosure request for the same reason that it's being defined as a service  
13request. And I think that having two separate claim elements within claim 9,  
14the service request and the disclosure request, it would be improper to  
15interpret each of the elements to mean the same thing.

16 JUDGE FISCHETTI: Counsel, if I have an invoice for example and I  
17had a price next to its description, isn't that serving two purposes in one  
18document?

19 MR. MERKIN: Your Honor, let me make sure I understand. The  
20invoice, it's sort of a subcomponent. You're saying the price is within the  
21invoice?

22 JUDGE FISCHETTI: Right, so you have basically two functions in  
23one document. You have a description of the service or product and then  
24you also have another data, which is the price. So you have two different  
25data sharing the same field, the same document.



1 MR. MERKIN: Right, yes, I understand your point. I think that's  
2 valid, but I don't think in this claim that I don't think that's a reasonable  
3 interpretation to interpret the disclosure request as a subcomponent or as a  
4 component of the service request. I think you are correct where the claimant  
5 does not disclaim the service request from being a portion of that, but at the  
6 same time I don't feel that that's a reasonable interpretation considering they  
7 are two separate elements that don't necessarily, as they are claimed, do not  
8 seem to overlap as much as the embodiment or example that you're citing in  
9 Sirbu and the example that you just gave such as a price and invoice.

10 We have a service request, which is like I said, the request from the  
11 user to provide a service to the service provider, and the disclosure request,  
12 which is essentially a separate statement from the user and then from the  
13 merchant also to the merchant and the accounting system that more  
14 information is needed -- that the service request should be disclosed. Does  
15 that make sense? So the user is providing a disclosure request in order to  
16 then disclose the service request.

17 So, as I understand it, hypothetical; but I don't believe that correlates  
18 to the claim terms as claimed here with the service request and disclosure  
19 request, whichever, which are two separately independent-type elements.

20 JUDGE FISCHETTI: But not recited as such in the claim as separate,  
21 independent elements. Right?

22 MR. MERKIN: That is correct. I don't believe they are expressly  
23 recited, but I believe that a reasonable interpretation would consider them  
24 separately or consider them to be two different pieces that don't necessarily  
25 overlap. And I would also point out that the examiner didn't make this  
26 argument, and I understand it.

1       And it seems that the examiner expressly did define the disclosure  
2request as the original EPO and the service request as the countersigned  
3EPO. And based on what the examiner has provided to the applicant, the  
4definitions are not inconsistent and not all disclosed within the single efforts.

5       JUDGE FISCHETTI: Well, thank you. I appreciate your time.

6       JUDGE CRAWFORD: Oh, is that it? Any questions, Judge Horner?

7       JUDGE HORNER: No, thank you.

8       JUDGE FISCHETTI: I'm okay. Thank you.

9       JUDGE CRAWFORD: Okay, thank you.

10      MR. MERKIN: Thank you very much.

11               [The hearing was adjourned.]